

**REMARKS**

In response to a restriction requirement mailed August 26, 2005, Applicant elected to prosecute Claims 1-9, without traverse. In the instant Office Action, the Examiner has raised several issues, which are set forth by number in the order they are addressed herein:

- 1) Claims 1, 2 and 5-9 stand rejected under 35 U.S.C. 102(b) as allegedly anticipated by U.S. Patent No. 4,892,296 to Jelinek (Jelinek);
- 2) Claim 4 stands rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Jelinek; and
- 3) Claim 3 stands rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Jelinek in view of U.S. Patent No. 3,910,621 to Hillier (Hillier).

Applicant has amended Claims 1 and 3-5, canceled Claims 2 and 17-25, and entered new Claim 26, in order to further the prosecution of the present application and Applicant's business interests, yet without acquiescing to the Examiner's arguments. Applicant reserves the right to prosecute the original, similar, or broader claims in one or more future application(s).

**1) The Claims Are Novel Over Jelinek**

The Examiner has rejected Claims 1, 2 and 5-9 under 35 U.S.C. §102(b) as allegedly anticipated by Jelinek. The Examiner states that "[p]rior to assembling the top plate 10, the device [of Jelinek] comprises a grid 14, 18, a screen 28, and a tank 20 connected to a source of vacuum" (Office Action, page 2). Applicant respectfully disagrees that U.S. Patent No. 4,892,296 to Jelinek anticipates the claimed invention. Nonetheless, Applicant has amended Claims 1 and 3-5, canceled Claims 2 and 17-25, and entered new Claim 26, in order to further the prosecution of the present application and Applicant's business interests, yet without acquiescing to the Examiner's arguments, and while reserving the right to prosecute the original, similar, or broader claims in one or more future application(s). Specifically, Applicant has amended Claim 1 to recite "wherein said screen is made of a rigid material and is suitable for supporting said plurality of tiles," and that said apparatus comprises "a vacuum pump connected to said outlet of said tank, wherein said vacuum pump is suitable for applying negative pressure to said open end of said tank." Claims 3-5 have been amended to depend upon Claim 1. Support for the amendment is found throughout the application as filed, as well as in original Claim 2 (now canceled). In particular, Applicant teaches that the screen is made of a "rigid material such

as metal” and that the screen “acts as a support and leveler, and through which a vacuum is applied to the front surfaces of a plurality of tiles through a plurality of holes (Specification, page 7, lines 26 and 27; and page 5, lines 16-18). In addition, Applicant has added new Claim 26, which recites “wherein said negative pressure is less than 5 torr.” Support for the new claim is found for instance in the definition section, which teaches that “the negative pressure applied to the top surfaces of a plurality of tiles is less than approximately 5 torr” (Specification, at page 6, lines 5-7).

In the first place in contrast to the Examiner’s assertion, the member (frame) 14 and partition arrangement 18 of Jelinek are not equivalent to the grid of the claimed apparatus “comprising a **plurality of slots for ordering a plurality of tiles**” (or other work pieces). Rather elements 14 and 18 form cubicles, and “the amount of suction applied to each cubicle interior varying in accordance with each different suction distributing position” [of said shutter means] (Jelinek, abstract and Claim 1). Additionally, the member 14 and partition arrangement 18 of Jelinek are sandwiched between a shutter means 28 and 32 and a sheet 10 (Jelinek, Figure 1) and thus are not suitable for contacting, let alone ordering work pieces (e.g., tiles). Secondly, Jelinek does not teach a “screen comprising a **plurality of holes corresponding to said plurality of slots** of said grid” as required by Claim 1. Instead, Jelinek simply discloses plates 28 and 32, neither of which apparently having perforations corresponding to the cubicles 18 of member 14 having a partition arrangement 16 (Jelinek, Figure 1). Thirdly, Jelinek does not teach a **vacuum pump** “for applying negative pressure to said open end of said tank,” as required by Claim 1. Instead Jelinek simply discloses a single suction producing means in the form of a “suction producing electric fan and a housing in which the fan is disposed” (Jelinek, Claim 4). Moreover, the modest suction needed by Jelinek for temporarily holding fabric to a table surface would not require a vacuum pump, nor would it suggest the use of one. As Jelinek fails to provide multiple elements of the pending claims, Jelinek does not anticipate the claims.

## **2) The Claims Are Non-Obvious Over Jelinek**

The Examiner has also rejected Claim 4 under 35 U.S.C. §103(a) as allegedly unpatentable Jelinek. The Examiner states that the:

type of vacuum pump employed is no more than an obvious matter of design choice absent a showing of criticality of this feature. The examiner takes Official Notice that vacuum pumps of the rotary vane type are well known. To employ a rotary vane vacuum pump in Jelinek would have been obvious inasmuch as this is a readily available type of vacuum pump” (Office Action, page 2).

In addition to the deficiencies noted above, Jelinek provides no teaching or suggestion to utilize a vacuum pump as a suction producing means in place of the disclosed electric fan. Applicant further contends that the use of a vacuum pump (such as the rotary vane type vacuum pump, which in preferred embodiments is capable of producing a negative pressure of less than 5 torr as recited in the Claims 1 and 26 respectively) is a critical feature of the apparatus. In particular, the vacuum pump of the claimed apparatus must apply sufficient negative pressure to the open end of the tank to cause the finished faces of the mosaic tiles to be leveled in the same plane, and to immobilize the mosaic tiles placed in the apparatus until the adhesive affixing the tiles to a backing has set (Specification, at page 9, lines 15-27). Since two of the three necessary elements of a *prima facie* case of obviousness cannot be made on the basis of Jelinek, Applicant respectfully requests that this rejection be withdrawn.

### **3) The Claims Are Non-Obvious Over Jelinek in View of Hillier**

The Examiner has rejected Claim 3 under 35 U.S.C. §103(a) as allegedly unpatentable over Jelinek in view of Hillier. The Examiner is reminded that to rely on a reference under 35 U.S.C. §103, it must be analogous prior art. Applicants respectfully submit the Examiner has both inappropriately relied on nonanalogous prior art, as well as having failed to establish a *prima facie* case of obviousness.

Specifically, “[i]n order to rely on a reference as a basis for a rejection of an applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.”<sup>1</sup> As is evident from both the title and abstract of the instant application, Applicant's invention is primarily directed to producing sheets of mosaic tile. In contrast, the patent of Jelinek is directed to “sewing together pieces of fabric” (Jelinek, column 1, lines 5-8), while the patent of Hillier is

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<sup>1</sup> MPEP 2141.01(a) citing *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).


directed to "lifting articles of large surface area, for example, uncured concrete panels" (Hillier, column 1, lines 5 and 6). Thus, Applicant contends that both Jelinek and Hillier are non-analogous prior art, which cannot be relied upon to support an obviousness rejection.

Even so, this rejection is moot as the primary reference Jelinek does not teach multiple elements of the independent claim as detailed above, and because Hillier does not remedy these deficiencies. Since the amended claims are not obvious in view of Jelinek and Hillier, Applicant respectfully requests that this rejection be withdrawn.

### CONCLUSION

Applicant believes the arguments and amendments set forth above traverse the Examiner's rejections and, therefore requests that a timely Notice of Allowance be issued in this case. However, should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicant encourages the Examiner to call the undersigned collect.

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By:   
Christine A. Lekutis  
Registration No. 51,934

MEDLEN & CARROLL, LLP  
101 Howard Street, Suite 350  
San Francisco, California 94105  
415.904.6500